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10/625,909	07/24/2003	Marco Stura	59643.00294	1209

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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,909

Applicant(s)

STURA ET AL.

Examiner

Eliseo Ramos-Feliciano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006 (RCE).
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 and 8-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Art Unit – Notice

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 26, 2006 has been entered.

Claim Rejections - 35 USC § 112

3. Previous rejections under 35 U.S.C. 112, first and second paragraphs, to the claims are withdrawn in view of Applicant's amendment filed April 26, 2006.

Claim Rejections - 35 USC § 101

4. Previous rejection under 35 U.S.C. 101 to the claims is withdrawn in view of Applicant's amendment filed April 26, 2006.

Double Patenting

5. Applicant is advised that should **claim 29** be found allowable, **claim 30** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing,

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despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

REMARK: previous dependency indicates claim 29 would have corresponded to claim 1, while claim 30 would have corresponded to claim 3. The amendment filed April 26, 2006 is identical on both; consequently a substantial duplicate thereof.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-6 and 8-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gemmer (US Patent Application Publication 2004/0022233 A1) in view of the Admitted Prior Art (in general paragraphs 0002-0015 of the present disclosure under the Background of the Invention; in particular as cited below).

Regarding **claim 1**, Gemmer teaches a telecommunications terminal that is part of a telecommunications system (paragraphs 0001-0002). Gemmer further teaches ISDN and Centrex networks (paragraphs 0003 and 0016-0020) of which the telecommunications terminal and/or the telecommunications system can be part of. Therefore, Gemmer discloses user equipment associated with a first access network and a second network. The networks could also be DECT and/or GSM (paragraph 0019). Gemmer's telecommunications system, ISDN, Centrex, DECT and/or GSM networks interchangeably read on claim language as claimed.

Gemmer discloses a method (e.g. page 2, right column) for supporting a communication session (e.g. call) of user equipment associated with a first access network, by a communication system (SYS) comprising at least one entity between said user equipment and a node with which the user equipment is arranged to establish a session via a second network, the method comprising the steps of:

a) establishing said session (call) between the user equipment (A or TEA) and the node (B or TEB) via said at least one entity (VER) (“the first connection (A) is actively engaged in a call to a second connection (B)” – page 2, claim 1, lines 5-7);

b) putting the session on hold (“the connection to the second connection (B) and the call arriving at the first connection (A) are held” – page 2, claim 1, lines 7-8; also page 1, paragraph 0003, lines 11-12);

c) reserving resources for said session while said session is on hold (resources are reserved because the connection with B is held by the switching center VER while a connection between A and C progresses) (“In order to make it possible to resume the connection to the connection B at some later time, this connection can be held by the switching center VER.” – page 2, paragraph 0021, lines 8-10); and

d) resuming said session with a message (“the call connection which was placed on hold between the first connection and the second connection (B) can be picked up once again” – page 2, claim 1, lines 14-16; also page 1, paragraph 0003, lines 15-16); and distributing charging information (page 1, paragraph 0003, line 17; page 2, paragraph 0020, line 8).

Gemmer clearly suggests that the networks could also be DECT and/or GSM (paragraph 0019). One of ordinary skill in the art would easily recognize that Gemmer’s telecommunications

system, ISDN, Centrex, DECT and/or GSM networks are different as claimed. Thus, Gemmer's telecommunications system, ISDN, Centrex, DECT and/or GSM networks interchangeably read on claim language as claimed.

Further, Gemmer suggests that the system can be GSM (page 2, paragraph 0019, line 5). Nevertheless, Gemmer fails to specifically disclose that the message distributes an access network charging identifier (for charging purposes) as defined by applicant.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on page 4, paragraph 0013 of the present disclosure under the Background of the Invention section and paragraphs 0039-0040 teaches that GPRS (a particular GSM service) typically requires a GGSN entity, a P-CSCF (PDF) entity, a GPRS charging identifier (GCID) sent from the GGSN to the P-CSCF (PDF) typically using COPS to enable charging. GPRS is a particular GSM service. GSM is 3G. Therefore, combinable with Gemmer's teachings given that Gemmer teaches that the system can be GSM (page 2, paragraph 0019, line 5 of Gemmer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer's invention with a charging identifier or vector as required by GPRS because GPRS is a particular GSM service and Gemmer teaches that the system can be GSM; therefore, these would be particular requirement of a particular system as choice of engineering design.

Regarding **claim 2**, Gemmer discloses everything as applied above (see *claim 1*). Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5). Nevertheless, Gemmer fails to specifically disclose determining if charging information is

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provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on page 5, paragraph 0015 of the present disclosure under the Background of the Invention section teaches that release 6 for third generation standard (3G) typically requires charging information not to be provided for a communication session. Consequently, there is no need to distribute charging information because it is not provided under 3G release 6. It should be noted that GSM is 3G. For that reason, Gemmer's invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determining if charging information is provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided in Gemmer in order to comply with release 6 for third generation standard as Gemmer's invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Regarding **claim 3**, Gemmer teaches a telecommunications terminal that is part of a telecommunications system (paragraphs 0001-0002). Gemmer further teaches ISDN and Centrex networks (paragraphs 0003 and 0016-0020) of which the telecommunications terminal and/or the telecommunications system can be part of. Therefore, Gemmer discloses user equipment associated with a first access network and a second network. The networks could also be DECT and/or GSM (paragraph 0019). Gemmer's telecommunications system, ISDN, Centrex, DECT and/or GSM networks interchangeably read on claim language as claimed.

Gemmer discloses a method (e.g. page 2, right column) for supporting a communication session (e.g. call) of user equipment associated with a first access network, by means of a communication system (SYS) comprising at least one entity between said user equipment and a node with which the user equipment is arranged to establish a session via a second network, the method comprising the steps of:

a) modifying an existing session (call) between the user equipment and the node via said at least one entity (the existing session/call is modified in the sense it is interrupted; then placed on hold) (“interrupting the existing connection” “while the first connection (A) is actively engaged in a call to a second connection (B)” – page 1, paragraph 0003, lines 9-10; page 2, claim 1, lines 5-7);

b) putting the session on hold (“the connection to the second connection (B) and the call arriving at the first connection (A) are held” – page 2, claim 1, lines 7-8; also page 1, paragraph 0003, lines 11-12);

c) reserving resources for the modified session while said session is on hold (resources are reserved because the connection with B is held by the switching center VER while a connection between A and C progresses) (“In order to make it possible to resume the connection to the connection B at some later time, this connection can be held by the switching center VER.” – page 2, paragraph 0021, lines 8-10); and

d) resuming said session with a message (“the call connection which was placed on hold between the first connection and the second connection (B) can be picked up once again” – page 2, claim 1, lines 14-16; also page 1, paragraph 0003, lines 15-16); and distributing charging information (page 1, paragraph 0003, line 17; page 2, paragraph 0020, line 8).

Gemmer clearly suggests that the networks could also be DECT and/or GSM (paragraph 0019). One of ordinary skill in the art would easily recognize that Gemmer's telecommunications system, ISDN, Centrex, DECT and/or GSM networks are different as claimed. Thus, Gemmer's telecommunications system, ISDN, Centrex, DECT and/or GSM networks interchangeably read on claim language as claimed.

Further, Gemmer suggests that the system can be GSM (page 2, paragraph 0019, line 5). Nevertheless, Gemmer fails to specifically disclose that the message distributes an access network charging identifier (for charging purposes) as defined by applicant.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on page 4, paragraph 0013 of the present disclosure under the Background of the Invention section and paragraphs 0039-0040 teaches that GPRS (a particular GSM service) typically requires a GGSN entity, a P-CSCF (PDF) entity, a GPRS charging identifier (GCID) sent from the GGSN to the P-CSCF (PDF) typically using COPS to enable charging. GPRS is a particular GSM service. GSM is 3G. Therefore, combinable with Gemmer's teachings given that Gemmer teaches that the system can be GSM (page 2, paragraph 0019, line 5 of Gemmer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer's invention with a charging identifier or vector as required by GPRS because GPRS is a particular GSM service and Gemmer teaches that the system can be GSM; therefore, these would be particular requirement of a particular system as choice of engineering design.

Regarding **claim 4**, Gemmer discloses everything as applied above (see *claim 3*). Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5).

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Nevertheless, Gemmer fails to specifically disclose determining if charging information is provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided.

The prior art admitted by applicant (simply “Admitted Prior Art”) disclosed on page 5, paragraph 0015 of the present disclosure under the Background of the Invention section teaches that release 6 for third generation standard (3G) typically requires charging information not to be provided for a communication session. Consequently, there is no need to distribute charging information because it is not provided under 3G release 6. It should be noted that GSM is 3G. For that reason, Gemmer’s invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determining if charging information is provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided in Gemmer in order to comply with release 6 for third generation standard as Gemmer’s invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Regarding **claims 5-6**, Gemmer discloses everything as applied above (see *claim 1*). Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5). Nevertheless, Gemmer fails to specifically disclose using SIP for the session as claimed.

The prior art admitted by applicant (simply “Admitted Prior Art”) disclosed on pages 2-3, paragraphs 0008-0009 of the present disclosure under the Background of the Invention section teaches that SIP is typically required by newer releases for third generation standard (3G). SIP

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enables two-way telephone calls as well as multi-way conference sessions. It should be noted that Gemmer's GSM is 3G and that Gemmer's session/call is at least a two-way telephone call.

UMTS is based on GSM and is 3G. It implements SIP as claimed (see paragraphs 0008-0009 of Admitted Prior Art).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer's invention with SIP in order to comply with newer releases for 3G as it would be a particular requirement of a particular system.

Regarding **claims 8-18**, Gemmer discloses everything as applied above (see *claim 1*). However, Gemmer fails to specifically disclose GCID, a P-charging vector, a GGSN entity, a P-CSCF entity, a PDF function, COPS messages, and a user agent server as defined by applicant.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on page 4, paragraph 0013 of the present disclosure under the Background of the Invention section and paragraphs 0039-0040 teaches that GPRS typically requires a GGSN entity, a P-CSCF (PDF) entity, a GPRS charging identifier (GCID) sent from the GGSN to the P-CSCF (PDF) typically using COPS to enable charging. GPRS is a particular GSM service. GSM is 3G. Therefore, combinable with Gemmer's teachings given that Gemmer teaches that the system can be GSM (page 2, paragraph 0019, line 5 of Gemmer). A user agent server as claimed is a particular requirement of 3G release 5 (see paragraph 0014 of the Admitted Prior Art).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer's invention with a charging identifier or vector, GCID or ICID, a P-charging vector, a GGSN entity, a P-CSCF entity, a PDF function, COPS messages, and a user agent server as required by GPRS because GPRS is a particular GSM

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service and Gemmer teaches that the system can be GSM; therefore, these would be particular requirement of a particular system as choice of engineering design.

However, Gemmer fails to specifically disclose a user agent server as claimed. Such is a particular requirement of 3G release 5 (see paragraph 0014 of the Admitted Prior Art)

Regarding **claim 19**, Gemmer and the Admitted Prior Art disclose everything as applied above (see *claim 5*). In addition, the Admitted Prior Art discloses charging information is sent in an INVITE message as claimed (via UPDATE message; paragraphs 0013-0014).

Regarding **claim 20**, Gemmer discloses everything as applied above (see *claim 1*). In addition, the establishing step comprises establishing a session wherein said node comprises user equipment (B or TEB) (see citations above).

As to **claims 21, 23, 25, 27, and 31**, being corresponding claims to method claim 1; they are rejected for the same reasons explained above.

As to **claims 22, 24, 26, 28, 29, 30, and 32**, being corresponding claims to method claim 3; they are rejected for the same reasons explained above.

Examiner's Remarks

8. As previously indicated, it has been noticed that the drawings of Gemmer (US Patent Application Publication 2004/0022233 A1) do not appear to match with Gemmer's written description. However, the rejection is based on the written description, not the drawings. The figures referenced in the Gemmer's written description are not of record. It has been noticed, however, that Gemmer finds adequate support in the priority document (PCT/DE01/03975 published as WO 02/34003) as it contains the same as in the US Patent Application Publication

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to Gemmer. For Applicant's convenience a copy of WO 02/34003 has been provided attached to a previous Office action.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment of the claims enlightened Examiner's new interpretation of the claims and made the claims clearly open to rejection based on new interpretation of the amended claims.

Applicant's arguments are directed to the newly added limitations. Such changes have now been treated on the merits and a detailed explanation can be found above.

Conclusion

10. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro, can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ELISEO RAMOS-FELICIANO
PRIMARY EXAMINER

ERF/erf

August 4, 2006